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Note: With the change of administration effective on January 20, 2001, Nicholas P. Godici [Commissioner for Patents] is now the Acting Under Secretary for Intellectual Property and Acting Director of the United States Patent and Trademark Office. This column will resume next month with a message from Mr. Godici.

Eighteen-Month Publication: An Overview

by Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration

Beginning in mid-March 2001, the USPTO will begin to publish utility and plant patent applications. Before November 29, 2000, utility and plant patent applications that were filed in the United States were required to be kept in confidence and a patent applicant had no enforceable patent rights before the issue date of a patent. With certain exceptions, utility and plant applications for patents filed on or after November 29, 2000, including international applications which are filed under 35 U.S.C. 363 on or after November 29, 2000, and are in compliance with 35 U.S.C. 371, will be published promptly after the expiration of a period of 18 months from the earliest domestic or foreign filing date of the application. In exchange for publication of a patent application, patentees may be able to obtain a reasonable royalty during the period beginning on the date of publication of the application by the USPTO or the date of publication under the Patent Cooperation Treaty (PCT) of an international application designating the United States and ending on the date the patent is issued ("provisional rights"). See 35 U.S.C. 154(d).

Plant and Utility Patent Applications filed after November 29, 2000 may be published.

Publication of utility and plant patent applications is required by the American Inventors Protection Act of 1999, Public Law 106-113. Final rules related to publication of patent applications, titled

Changes to Implement Eighteen-Month Publication of Patent Applications, were published in the *Federal Register* on September 20, 2000 (65 *Fed. Reg.* 57024), and in the *Official Gazette* on October 10, 2000 (1239 *Off. Gaz. Pat. Office* 63).

An application will not be published if an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires 18-month publication. The office form for a non-publication request is PTO/SB/35. Countries that do not require publication at 18 months currently include Algeria, Belarus, Belgium, Iran, Iraq, Kazakhstan, Malaysia, Mongolia, Morocco, Philippines, Saudi Arabia, Syria, and Vietnam. There is no provision to accept this request after the filing date of the application, as the requirement for any request for non-publication to be made on filing is a statutory requirement.

An applicant may rescind a non-publication request at any time. The form to rescind a non-publication request is PTO/SB/36. An applicant who has made a non-publication request but who subsequently files an application directed to the invention disclosed in the application filed in the office in a foreign country, or under a multilateral international agreement, that requires 18-month publication, must notify the office of such filing within 45 days after the date of the filing of such foreign or international application. An applicant's failure to timely provide such a notice to the office will result in abandonment of the application (subject to revival if it is shown that the delay in submitting the notice was unintentional). If an applicant rescinds such a request or notifies the office that an application was filed in a foreign country, or under a multilateral international agreement, that requires 18-month publication, the application is subject to 18-month publication. See 35 U.S.C. 122(b)(2)(B)(i)-(iv).

Additionally, an application will not be published if it is: (1) no longer pending; (2) subject to a secrecy order under 35 U.S.C. 181 or an application for which publication or disclosure would be detrimental to national security; (3) a provisional application under 35 U.S.C. 111(b); or (4) an application for a design patent under 35 U.S.C. chapter 16. See 35 U.S.C. 122(b)(2)(A) and (d). Further, a regular plant/utility application filed prior to November 29, 2000, will only be published if an applicant requests publication. See 37 CFR 1.221(a). Because a non-publication request must be made on filing an application, applicants who file a patent application, without a non-publication request, and want to avoid publication may wish to consider expressly abandoning the application under 37 CFR 1.138(c), and filing a continuation with a non-publication request. This new rule permits an applicant to petition for express abandonment to avoid publication, but further provides

that the express abandonment will not be recognized if the request is received too late to avoid publication. An applicant should ensure that the petition is before the appropriate deciding official at least four weeks before the publication date of the application by mailing petitions under 37 CFR 1.138(c) to BOX PGPUB- ABD.

The fee covering the cost of any publication required by 35 U.S.C. 122(b) will be required with the Notice of Allowance and Issue Fee Due, unless an applicant requests early publication. If an application becomes abandoned and does not issue as a patent, no publication fee is required. The fee is currently \$300, and no small entity discount is available. If an applicant requests early publication, then the publication fee will be required when early publication is requested. See 37 CFR 1.219.

The fee for publishing an application filed on or after November 29, 2000, is \$300.

Applicants will be informed of the publication date assigned to the application on the filing receipt. Patent application publications will have a similar appearance to a U.S. patent. Patent application publications will be assigned a unique number, followed by a capital A, and a number. Before January 2, 2001, patents were issued with “A1” following the patent number, but since the A designation is the international standard for the first publication, beginning on January 2, 2001, patents have been issued with “B1” following the patent number. Patent application publications will be classified according to the U.S. Classification and the International Patent Classification systems and included in electronic databases of the USPTO so that they are searchable in the same manner as patents. Copies of patent application publications will not be mailed to applicants, but will be freely downloadable from the USPTO Web site (www.uspto.gov). In addition, upon publication, a member of the public will be able to obtain a copy of the file wrapper of a published application. 37 CFR 1.14(c)(1)(ii).

The patent application publication will generally be composed from the patent application papers as originally filed and will only include a preliminary amendment if the preliminary amendment is necessary to make the application complete (e.g., the amendment includes claims and the other application papers do not include claims). If a continued prosecution application (CPA) is filed on or after November 29, 2000, the application that will be published will be the first-filed application in the CPA file jacket, unless the applicant files a replacement copy of the specification (including claims) and drawings through the Electronic Filing System (EFS). Since amendments other than those required by the Office of Initial Patent Examination (OIPE) will only be included in a patent application if a copy of the amended application is submitted through the EFS, applicants should review applications before filing to ensure that the originally-filed application is suitable for publication. For further

information about EFS see the Electronic Business Center on the USPTO homepage (www.uspto.gov). One exception to the general provision that amendments will not be included unless required by the OIPE is drawings filed within a certain time period, with a \$130 fee, and mailed to Box PGPUB DRAWINGS will be included in the patent application publication.

Publication of the patent application publication may be delayed if the application papers submitted on the filing date of the application do not include the content needed (e.g., an abstract or an executed oath or declaration) or the application papers or drawings are not of sufficient quality to be used to create a patent application publication. In such a situation, the OIPE will issue a notice requiring that the applicant submit the needed application content or application papers or drawings of sufficient quality for use in creating a patent application publication. The applicant's reply to that notice (application papers and drawings needed to create the patent application publication) then will be used for composing the patent application publication.

Publication of patent applications is an important change to U.S. patent law. Most other countries publish patent applications, but those publications are often not in English. Once patent applications are published in the United States, inventors will be able to see the technology sought to be patented by others in a publication that is in the English language, at a much earlier time than the document would be otherwise available. In addition, patent application publications may be used as prior art under 35 U.S.C. 102(e) in applications filed on or after November 29, 2000, and in applications that filed before November 29, 2000, that are voluntarily published under 35 U.S.C. 122(b). Applicants will be able to defeat the patents of others without recourse to the harsh and comparatively more expensive provisions of a statutory invention registration (35 U.S.C. 157), and ensure that inventions that they choose not to patent are not patented by others.

Patent application publications are expected to be a primary source of prior art and may be prior art under 35 U.S.C. 102(e).

The IP Agenda on Capitol Hill: Unfinished Business Awaits Action

by Tod Preston, Office of Legislative and International Affairs

The 106th Congress will go down in history as one of the longest in recent memory. In fact, by the time it adjourned on December 18, 2000, Congress had passed a record 21 continuing resolutions to keep the federal government funded in the new fiscal year.

While the first year of the 106th Congress saw action on several intellectual property (IP)-related measures — notably enactment of the landmark “American Inventors Protection Act of 1999” — last year’s impasse over budgetary matters stymied additional progress on a number of IP-related issues. Whether the new, more evenly divided 107th Congress will be able to overcome this logjam remains to be seen.

The 106th Congress

While a few pieces of IP-related legislation were debated or approved by either the House or Senate during the second half of the 106th Congress, final adoption and enactment proved illusory. One important IP bill that met this fate was H.R. 4034, the “United States Patent and Trademark Office Reauthorization Act.” Sponsored by House Judiciary Subcommittee on Courts and Intellectual Property Chairman Howard Coble (R-NC), H.R. 4034 would end the annual diversion of USPTO fee revenue by permitting the agency to access all its fees without prior authorization in appropriation Acts. Thanks to the strong support of Chairman Coble, Subcommittee Ranking Member Howard Berman (D-CA), Judiciary Chairman Henry Hyde (R-IL), and many in the IP community, the House Judiciary Committee approved this landmark measure on May 9, 2000. Regrettably, strong opposition from members of the Appropriations Committee derailed further action on the bill and its fate this year is uncertain.

The USPTO’s budget situation was also clouded last year during consideration of fiscal year 2001 appropriations. Things got off to a troubling start in June when the House passed a budget measure that would have funded the USPTO at \$904 million, \$134 million less than the administration’s budget request. Fortunately, thanks to the hard work of many USPTO allies, the Senate subsequently adopted a measure that funded the agency at \$1.039 billion, consistent with the president’s budget request; this was the final level adopted by Congress on December 15, 2000. Of that \$1.039 billion, \$784 million is derived from fiscal year 2001 fees (currently projected at \$1.2 billion) and \$255 million comes from USPTO fees that had been diverted in fiscal year 1999 and fiscal year 2000.

At the same time Congress was grappling with these budgetary matters, two noteworthy pieces of patent legislation were introduced in the House. The first of these was H.R. 4870, the “Intellectual Property Technical Amendments Act of 2000,” sponsored by Reps. Coble and Berman. Adopted by the House on September 19, 2000, the bill makes miscellaneous technical and clerical changes to the U.S. Code to clarify provisions of the American Inventors Protection Act of 1999 (AIPA). For example, the bill changes the title of the head of the USPTO from “Director” back to the traditional title of “Commissioner.”

In addition to fine-tuning the AIPA, certain method patents also came under scrutiny with the introduction on October 3, 2000, of H.R. 5364, the “Business Method Patent Improvement Act of 2000.” Sponsored by Reps. Berman and Rick Boucher (D-VA), the bill attempts to define “business method” and “business method invention,” requires applications for patents on a business method invention to be published 18 months after filing, and establishes pre-grant and post-grant opposition proceedings. The USPTO has several concerns with the legislation and has been working with its sponsors in the hope that those concerns will be addressed if and when the measure is reintroduced.

On the Trademark front last year, the biggest issue on Capitol Hill was the ratification and implementation of the Madrid Agreement on the International Registration of Marks (Madrid Protocol). The Protocol, which was adopted in June 1989, and went into effect in April 1996, would significantly streamline the trademark registration process by permitting U.S. trademark owners to file for registration in any number of 65 member countries by filing a single standardized application, in English, with a single set of fees at the USPTO.

While Senate ratification of the Protocol accession package had been expected, the measure stalled in the Senate Foreign Relations Committee last Fall due to a battle between Bacardi & Co., a Bahamian corporation, and Pernod-Ricard, a French corporation, over the rights of Pernod-Ricard and its Cuban government joint-venture partner to U.S. ownership rights in the trademark “HAVANA CLUB.” This disagreement was unable to be resolved in the waning days of the congressional session.

More progress was made on the Protocol’s implementing legislation, however. On February 10, 2000, the Senate Judiciary Committee approved S. 671, the “Madrid Protocol Implementation Act,” a similar version of which passed the House in 1999. The measure would require implementation of the Madrid Protocol within one year from the date of enactment.

In addition to these developments, Congress held several hearings last year on IP-related matters. For example, Under Secretary and Director Q. Todd Dickinson testified before subcommittees of the House Judiciary and International Relations Committees on genomic patents, domestic and international IP enforcement, Internet piracy, and state sovereign immunity and federally-protected IP rights. A general USPTO oversight hearing was also conducted by the House Judiciary Subcommittee on Courts and Intellectual Property.

The 107th Congress

A new Congress and a new administration will certainly bring changes to IP policy-making. For one, term limits on House committee and subcommittee chairs have recently forced shifts in the chairmanship of the House Judiciary Committee and a key House Appropriations Subcommittee. Rep. James Sensenbrenner (R-WI), who had previously served as the Chair of the House Science Committee, has replaced Rep. Hyde at the helm of the Judiciary Committee. (Rep. Hyde now chairs the International Relations Committee). In addition, Congressman Harold Rogers (R-KY) has been replaced by Congressman Frank Wolf (R-VA) as Chair of the House Appropriations Subcommittee on Commerce, Justice, State and Judiciary, which provides funding for the USPTO.

Against the backdrop of these changes, two issues that are likely to be focused on early in the congressional session are USPTO fee diversion and copyright protection, particularly as it relates to music-swapping services such as Napster. Indeed, key members of the House and Senate Judiciary and Commerce Committees have already indicated that they intend to examine whether traditional copyright law is keeping pace with the Internet revolution. Needless to say, it will be interesting to see how legislative action in this area unfolds.

With respect to patent policy, the patenting of business methods and genomics is likely to remain an area of interest. In addition, action is also possible on the AIPA technical corrections legislation, non-copyright protection for databases, and state sovereign immunity and federally-protected IP rights in the wake of the Supreme Court's 1999 *Florida Prepaid* decisions. On the trademark front, attention will once again focus on securing ratification and implementation of the Madrid Protocol.

In short, the 107th Congress will have its hands full on a number of public policy matters, including IP-related issues. Moreover, as intellectual property continues to play a more integral role in the health and vitality of the U.S. economy, these issues will garner greater attention on Capitol Hill.

Trademark Public Advisory Committee Meets Via Teleconference

by Jessie Marshall, Trademark Administrator, Office of the Commissioner for Trademarks

On Monday, November 20, 2000, the Trademark Public Advisory Committee held a meeting via teleconference. This was the first time a public advisory committee meeting has used that technology, and it turned out to be quite successful. Members from all around the country were connected by telephone and USPTO representatives joined in through a telephone link from a USPTO conference room. There was also an open line for the general public to make contributions to the meeting or simply listen in on the proceedings.

The meeting was opened by the T-PAC Chairperson, Miles Alexander, at 3:00 p.m. EST. The first item on the agenda concerned a proposed Examination Guide that would liberalize the present policy concerning the identification of goods and services in trademark applications. The purpose of the change in policy is to simplify the crafting and presentation of goods and services thereby making both preparation and examination of applications more efficient. Presently, the identification of goods and services is questioned in about 75 percent of the trademark applications filed in the USPTO.

The Examination Guide attempts to balance the need to reduce the delay in processing applications by reducing the number of inquiries that are made in this area with the requirements of the Lanham Act to issue clear and accurate trademark registrations. After a lengthy and spirited discussion, the T-PAC voted to endorse the Examination Guide with the recommendation that the guide be presented to the International Trademark Association and the American Intellectual Property Law Association as well as other interested groups such as NTEU 245, the union representing the trademark examining attorneys. Mr. Anderson indicated that the guide would be put out for public comment, changes made if necessary, and the final guide presented to NTEU 245 before implementation.

The next item on the agenda concerned the retention of USPTO user fees. The chairman and other members of the committee expressed frustration over the situation. While it became clear that the committee was, understandably, in full support of the USPTO keeping all user funds to enhance the efficiency and quality of its functions, the members were at a loss to know what they could do to convince Congress of the need for retention of the funds in the

USPTO. A discussion ensued in which the USPTO Office of General Counsel offered its advice concerning the activities that are or are not permitted by the T-PAC charter. Clearly, lobbying as the T-PAC or as an individual member of the T-PAC is not permitted. But similar action taken as private individuals would be allowed. However, it was also indicated that there could be political implications that should be taken into account, not in the least the position of the new administration concerning issues such as this. Further action was not clearly mandated, but the position of the T-PAC was made manifest and that position, namely, the overwhelming need that the USPTO be able to retain all user fees for its own use, would be reflected in the T-PAC report that would be sent to Congress.

The subject of electronic filing came next on the agenda. The USPTO has proposed that filing trademark applications electronically using the eTEAS system be made mandatory. The electronic filings greatly increase office efficiency and assure accuracy in the applicant's information that is transferred electronically into the USPTO database. Commissioner Anne Chasser's presentation on this issue indicated that mechanisms are being discussed for applicants that do not have access to or cannot use a computer for filing electronically as well as legal constraints that may be imposed by the Trademark Law Treaty or TRIPS. Members of the T-PAC representing both large corporations and small individual applicants gave full support to the USPTO's efforts to make electronic trademark application filing mandatory.

Following a discussion concerning the agenda for the next T-PAC meeting (which must remain confidential until the agenda is finalized at which time it will be made public), the meeting closed with Thanksgiving wishes and birthday greetings to Chairperson Alexander. The teleconference format was well-received by both the members of the committee and USPTO representatives. Future meetings will be held using the technology.

For a copy of the Trademark Public Advisory Committee Annual Report for 2000, see the USPTO Web page at www.uspto.gov.

Helpful Hints for patent applicants

Eighteen-Month Publication (PG Pub)

by Dick Apley, Director, Office of Independent Inventor Programs

The American Inventors Protection Act of 1999, Subtitle E, is titled “Domestic Publication of Patent Applications Published Abroad.” From this deceptively simple title emanates some of the most far reaching and sweeping changes that the patent system has seen since the Patent Act of 1836. It is worthwhile to note that patent historian P.J. Federico commented that the 1836 Act had this impact:

“For the first time in all history the means for ascertaining and decreeing rights of property and ideas and promoting the object of a system of patent protection was placed on an intelligent, scientific and adequate basis.”

The AIPA of 1999, and specifically PG Pub, comes close to matching the sweeping changes brought about by the 1836 Act. Like an iceberg that only shows 10 percent of its size, PG Pub only reveals its massive impact when it is read in conjunction with its implementing rules and procedures. This article is only going to touch upon 10 percent of PG Pub’s impact: the remaining 90 percent are urged upon you to study and understand. Remember The Titanic!!

1%... PG Pub applies to applications filed on or after November 29, 2000. It also provides, at the applicant’s request, certain provisions for “voluntary” and “early” publication. PG Pub lists the type of applications that will be published (e.g. new applications) and certain exceptions that will not be published (e.g. provisional or design applications).

2%... There are requirements for requesting not to publish (e.g. the request must be made at the time of filing); and conditions for publication after a non-publication request (e.g. an application is subsequently filed in another country, an applicant has 45 days to notify the USPTO or the application becomes abandoned).

3%... There is a redacted publication option. If corresponding foreign applications have a less extensive description than the U.S. application, the applicant may submit a redacted copy of the U.S. application for publication that eliminates subject matter not also contained in any of the corresponding foreign applications. How-

ever, it must be submitted within 16 months after the earliest filing date for which a benefit is sought and it must comply with the new USPTO electronic filing system (EFS) requirements.

4%... The publication will include creating a publication document called “Patent Application Publication” that becomes prior art and will be available on the USPTO’s electronic search system.

5%... USPTO will require that all utility and plant applications be in condition for publication when released to the appropriate technology center for examination. Therefore, haphazardly prepared or irregularly formatted applications will be held in the Office of Initial Patent Examination (OIPE) until corrected. For example, the specification must be of sufficient quality for optical character recognition conversion of image to text and the drawings must be of sufficient quality to permit the patent application publication to be used as a prior art document.

6%... Third party participation after publication will be permitted as long as the activity does not amount to protest or opposition. Therefore, patents and publications can be submitted without discussion under certain conditions.

7%... The time for making priority/continuity claims will be 16 months from the claimed priority date, or four months from the application filing date, whichever is later. This applies to claims under 35 USC Sections 119(a)-(d), (e), 120, 121, or 365.

8%... Provisional rights based on domestic publication. If a patent includes the right to a reasonable royalty for the period between the date of publication and date of patent grant, **provided** actual notice is given of the publication and the patent claims are substantially identical to the claims of the published patent application.

9%... There is a significant prior art effect of U.S. published applications. It is prior art under 35 USC Section 102(e)(1) as of its filing date. If the U.S. application was the result of a Section 371 national stage application, then the Section 102 (e)(1) date is its international filing date if the international application was published in English.

10%... Claims in published applications must be copied within one year of date of publication for interference purposes under 35 USC Section 135 (b).

There it is... 10 percent of the PG Pub iceberg. At the December 11, 2000 “Patent and Trademark Office Day,” Charles E. Van Horn, head of the Patent Prosecution Section for Finnegan, Henderson, Farabow, Garrett & Dunner L.L.P., stated that “Patent practitioners need to obtain knowledge and understanding of the many changes

that have taken place in patent practice.” Mr. Van Horn noted at least 13 important considerations impacted by the PG Pub section of the AIPA. These range from whether to publish or not to publish to monitoring published applications. I join with Mr. Van Horn in recommending that you thoroughly familiarize yourself with the provisions of PG Pub.

The Patent Business – Part Three

A Conversation with Stephen G. Kunin Deputy Commissioner for Patent Examination Policy

by Anne M. Houghton, Office of the Deputy Commissioner for Patent Resources and Planning

[Ms. Houghton is on detail assignment to the USPTO from the National Science Foundation.]



The following is part three of a four-part series on the Patent Business. Part one featured an interview with Commissioner of Patents, Nicholas Godici, and part two featured an interview with the Deputy Commissioner for Patent Resources and Planning, Edward “Kaz” Kazenske. Part three features an interview with Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy.

Stephen G. Kunin has over 30 years of experience within the USPTO and has served in posts throughout the organization. He holds both law and engineering degrees and has served as a guest lecturer to numerous law schools. He has received the prestigious Reinventing Government Hammer Award from the vice president as well as several top awards from the Department of Commerce. In this interview, he discusses the concept of the Patent Business from his perspective and the challenges facing examination policy.

AH - What does the term “Patent Business” mean to you?

SK – It is the job of the Patent Business to properly administer the patent laws of the United States to promote the progress of the useful

arts through the prompt issuance of high quality patents.

AH - As deputy commissioner for patent examination policy, what do you believe are the most significant challenges the Patent Business faces? What impact do these challenges have upon the examination process and what initiatives are you planning to address them?

SK - We have many challenges facing us in the 21st century. The biggest one is the retention of our revenues. The American Inventor's Protection Act did not free us from the appropriations process. Consequently, without access to all the revenues that we collect, it makes it very difficult for us to address challenges that require increased resources.

The next critical area is adequately addressing increased workloads. The growth in filings in the last couple of years has been in excess of 12 percent, and as a result, we are now planning to receive more than 300,000 patent application filings in 2001. If this trend continues, by 2006, we may receive as many as 600,000 patent applications. The implications of this are enormous from the standpoint of being able to recruit, train, and retain a high quality diverse workforce that is capable of examining these applications in a high quality and timely manner.

At the same time, we are being flooded with paper. If you look at the growth of our search files and central application files, you will see that we are literally drowning in paper. What we need to do, as we plan to move into the Carlyle site in 2004, is to transition from a predominantly paper-based process to one that relies on e-commerce and which will permit us to become a paperless office. It will be a difficult process that will take time and careful planning. This will improve efficiency and effectiveness while providing substantial savings in space, equipment, and file maintenance costs. It will have to be done in a way that recognizes that certain automation improvements will be needed to pave the way for the removal of paper.

We need to invest in automation in order for us to implement the electronic file wrapper system known as TEAM [Tools for Electronic Application Management] or EPAP [Electronic Patent Application Processing] systems. The movement of cases, paper matching, and so forth is a resource intensive process. We would hope that the movement to a paperless system will help us process applications with greater speed and accuracy.

When we are able to implement an electronic file wrapper system through the TEAM project, it will bring to fruition an e-commerce USPTO where our customers can do business with us entirely electronically. All communications from applicants and all communications from the office will be exchanged entirely in electronic form,

and we will employ electronic records management principles to take the place of our current paper-based processes.

However, automation for automation's sake is not going to solve our problems. We're going to have to continue to explore new ways to reengineer our business processes by looking at how we can reform our patent laws, work with our foreign office counterparts on cooperation in search and examination, as well as any rule or practice changes that will affect the way we process our workload.

The opportunity in the future for work sharing with foreign offices, particularly on applications that are common to our offices can be a real possibility. We will continue patent law harmonization talks, which may lead to a new patent law treaty sometime in the next five to 10 years. Further, we will pursue efforts on PCT reform and trilateral technical cooperation. We're also going to have to provide our staff, both professional and technical support, with just-in-time training on new laws, rules, guidelines, practices, and procedures.

AH – Will these all be tied to that electronic file wrapper?

SK - Yes. The electronic file wrapper system will have both workflow management and document management features that will ensure that each communication is appropriately recorded and authenticated. This will be done through use of the principles of electronic records management where we ensure the identity, authenticity, non-repudiation, and confidentiality of all communications, both from the applicant and from the office. Application documents will be preserved so you can see them at any stage of the prosecution. That will produce a legally admissible record for patent owners to use in enforcement proceedings.

AH – Patent applicants will be able to access their file wrapper and see what's in there on-line?

SK - The effort involves access and use of the patent application and information retrieval system known as PAIR [Patent Application Information Retrieval], where through the use of a digital certificate, applicants will be able to check on the status of the processing of their applications through the Internet. The public will be able to do so as well, when the application information moves to the public records side of the system. Then once we are able to implement the full electronic file wrapper system, when the application is in processing during the period of confidentiality, the applicant would be able to access it using a digital certificate and review the prosecution history online through a secure Internet channel. The public would be able to do the same once the application is laid open after publication or patent grant.

AH - The most recent edition of the Manual for Patent Examining

Procedure (MPEP) is being published. Are there any changes in the process in this edition that you'd like to highlight?

SK - We are currently working on the 8th edition. We hope to have it published in early spring or earlier if practicable. It will reflect all of the new changes that resulted from the implementation of the American Inventor's Protection Act, the implementation of our new patents business goals rule package that went into effect on November 7, and new examination guidelines. In particular, the appendices will show the current changes to Title 35 of the United States Code, as well as Title 37 of the Code of Federal Regulations. This will permit the users of the manual to have an up-to-date compendium of the new laws, rules, practices, and procedures that are needed for day-to-day patent examination.

AH- Would you say given the significance of the AIPA legislation that there are the most changes to this edition of the MPEP than any of the previous editions?

SK - I believe we try to do the best job we can with each revision to reflect all of the practice changes that have occurred since the prior publication. These changes normally result from new examination guidelines, new rule packages, recent decisions of the Court of Appeals for the Federal Circuit, and changes in business practices. So each revision or edition usually does contain some substantial changes. But as you so correctly indicated, the wide sweeping and significant changes that resulted from both the AIPA and the patent business goals will most definitely have a major effect on the content of the manual in the 8th edition.

AH - Will the Patent Business' future involvement in e-government alter examination policy? What major changes in policy, if any, do you foresee in the next five years as a result of increased involvement in e-government?

SK - There is no question that the government as a whole, and the USPTO in particular, will be systematically moving away from doing work in paper, both in terms of receipt of communications from the public, internal processing, and our information dissemination role. If you look at what is taking place in federal government in terms of the Paperwork Reduction Act, what is happening in the digital signature arena, and the widespread use of the Internet for communicating with customers, this is clearly a harbinger of change, which will have a major effect on the way we do business.

On October 27, we opened our new Patent Electronic Filing System for all patent applicants to file patent applications electronically using public key infrastructure principles. We will receive a structured patent application document using XML tags, which will be of immense benefit to us in the publication process. In addition, we will continue to

add increased capability in our EAST and WEST search systems for searching U.S. patents, foreign patents, and non-patent literature. These efforts will make the quality of our searching significantly better as we move deeper into the 21st century.

We are also looking at the implications of what will happen with pre-grant publication. In pre-grant publication, we will not be publishing most applications on paper. We will be publishing some applications only electronically. They will be full image and full text searchable. More and more, we will be relying upon electronic publication for many USPTO activities.

This will also be true in the future with respect to how we will do rule making. We will do more electronic rule making and receive comments on our rules electronically.

There is going to be continued work with our foreign exchange partners in exchanging patent information among offices in electronic form. We're moving globally to what's called a system of intellectual property digital libraries (IPDLs) through WIPOnet, where each office's IP information will be available on a decentralized and distributed basis. At some point, there will be what's called a "pull mechanism" so that you will be able to easily access each office's digital library over the network and extract information that you need when you need it.

We'll be continuing the work on the international priority document exchange program. Right now, applicants have to request from us a certified copy of their U.S. application on paper for filing in foreign offices to get Paris Convention priority benefit. We would like to see this move toward an electronic exchange on an office-to-office basis. Later we would like to exchange search reports and examination reports among offices, which may make work-sharing a reality.

Probably the most significant thing that we're looking forward to is that with the advent of a full paperless office and with the appropriate security mechanisms in place, we will be able to fully implement a work at home program. This will give us increased flexibilities, in terms of improving quality of work life and dealing with the variety of issues that are associated with how we obtain our workforce and where our workforce has to be physically located. This can be best accomplished when we are in a full e-government environment.

With respect to examination policies, we are studying requirements for maintaining confidentiality and privacy. We'll have to look at how we can operate in an environment that provides increased flexibilities to our employees while at the same time, serving our customer's needs and maintaining or improving access to our workforce for our customers.

What this means in terms of examination policies is that we'll have to look at issues such as establishing a secure e-mail system so that e-mail transactions of substance can be done between our employees and our customers using digital signature and encryption technology to authenticate the originator of the messages and ensure confidentiality. This will allow us to change our current way of doing business.

Almost every day we see new advances in wireless communications. We're looking forward to the second generation of the Internet. I think it will create a much more robust and flexible environment in which we can operate. Many businesses are now moving towards a 24/7/365 environment. This is a new direction we will need to explore. Doing so will have a profound effect on internal policies that will need to be carefully studied.

AH – Do you see most of these initiatives being in place within the next five years?

SK - If they're not fully in place within the next five years we'll at least have significant pilots or prototypes in place to do proofs of concept of these ideas. Many times, the devil is in the details, and so consequently, the best thing to do is to figure out the best way to get started and, if necessary, to do mid-course corrections. We may not get it exactly right the first time, but just talking about it is not going to get it done.

Consequently, with a concerted effort on a collaborative basis with contributions from all parts of the office, we will be able to make the kind of strides that we need to make these initiatives successful. It's good to establish stretch goals with a clear vision and a road map of how to get there and some fairly aggressive targets. If we succeed, that would be wonderful. It's the right and only way for us to go. If we can do it in five years, that would be great. But if we don't, I assure you, we will make best efforts to get as much implemented as successfully as we can within that timeframe.

AH – Any closing thoughts on examination policy or the patent business?

SK - I've been part of the patent business for over 30 years. We've done some great things as an office during that time and there are still greater things to be done. I am proud to have been part of this legacy of success. If we all continue to work together under the leadership of the under secretary and director and our commissioner for patents, as a strong team that respects diversity, shares ideas, and learns from best practices of others, we will succeed no matter what challenges the future may hold for us.

Faces of the USPTO

Lynne Beresford, formerly attorney-advisor in the Office of Legislative and International Affairs (OLIA) at the U.S. Patent and Trademark Office (USPTO), recently was named the agency's deputy commissioner for trademark policy and projects.



"I am extremely pleased that Lynne Beresford has accepted this important position," noted Anne Chasser, commissioner for trademarks. "Lynne Beresford brings to this position a superlative record of government service and a wide range of experience that will be helpful to the agency as we face the challenges of the years ahead," she said.

While with OLIA, Beresford was responsible for planning and implementing strategies to help achieve U.S. intellectual property goals in the international arena. In the past several years, she has chaired numerous meetings of the World Intellectual Property Organization's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. Under her chairmanship the Committee produced joint resolutions on the protection of well-known trademarks and on simplification of the recorded requirements for trademark licenses. Ms. Beresford was also a USPTO delegate to the diplomatic conference that negotiated the Trademark Law Treaty. She was also instrumental in fundamentally changing the U.S. approach to trademarks related to geographical indications in the Council for the Trade Related Aspects of Intellectual Property.

Ms. Beresford has been with the USPTO since 1978. She received both her Bachelor's degree in Accounting and her Juris Doctor degree from Rutgers, the State University of New Jersey.

Top Patent Recipients for Calendar Year 2000

The United States Patent and Trademark Office announced the top 10 private sector patent recipients for the 2000 calendar year. Listed below are the 10 corporations receiving the most patents for inventions in 2000, along with their ranking last year. For the eighth straight year, IBM received more utility patents than any other private sector organization.

For the year, the top 10 patenting organizations consist of four U.S. corporations, five Japanese corporations, and one corporation from the Republic of Korea. One U.S. corporation has been added and one Japanese corporation has been dropped from the list. The U.S. Government received 920 utility patents for the year.

Preliminary Rank in 2000*	Preliminary # Patents in 2000*	Organization*	(Final Rank) (in 1999)	(Final Number of) (Patents in 1999)
1	2,886	International Business Machines Corporation	(1)	(2,756)
2	2,020	NEC Corporation	(2)	(1,842)
3	1,890	Canon Kabushiki Kaisha	(3)	(1,795)
4	1,441	Samsung Electronics Co., Ltd.	(4)	(1,545)
5	1,411	Lucent Technologies Inc.	(9)	(1,152)
6	1,385	Sony Corporation	(5)	(1,410)
7	1,304	Micron Technology, Inc.	(14)	(933)
8	1,232	Toshiba Corporation	(6)	(1,200)
9	1,196	Motorola Inc.	(7)	(1,192)
10	1,147	Fujitsu Limited	(7)	(1,192)
	920	U.S. GOVERNMENT		(983)

* The listed patent counts are preliminary counts which are subject to correction. The final listing of 2000 patent counts for the top patenting organizations should be available by early April.

Please Note:

Patent information presented reflects patent ownership at patent grant and does not include ownership changes that occur after the patent grant. Where more than one assignee (owner) exists, patents are attributed to the first-named assignee.

USPTO Salutes...

oldest living registered patent practitioner

by Frankie Cox, Office of Public Affairs

C. Yardley Chittick celebrated his 100th birthday a couple of months ago. He was born on October 22, 1900, and is looking forward to 101. Mr.

Chittick, a former employee of the Patent Office, is truly a delightful man to talk with.

I had the pleasure of interviewing Mr. Chittick and found him to be fast with facts and figures, and spelling the names of firms he had worked for and people he had known. Mr. Chittick worked for the Patent Office from March 1931 until May 1934, as an assistant examiner of textile machinery. He earned \$1,900 a year back then, and his registration number is still 13782.

“That’s when the Patent Office was a stone building at 7th and F Street, N.W. I was still there when it moved to the fancy new building at 14th and Constitution Avenue, N.W. The Patent Office took up the entire north end of the building.”

Mr. Chittick told me about rooming across the hall from Humphrey Bogart when he attended Phillips Academy in Andover, Mass., in 1917-18. “Bogart didn’t last more than a year at the school, but he went on to become a very fine actor.” Mr. Chittick went on to graduate from MIT in 1922.

He also told me about his job interview with Thomas Edison in 1925. In order to work for Edison, you had to pass an exam and then you were considered for a position. Mr. Chittick passed the exam and went for the interview with Edison. “I thought it would probably be an OK place to work, but I really wanted another job at the Kroydon Company. That company offered me a position and so I passed on Edison.”

The Kroydon Company manufactured golf clubs and also promoted



new golf inventions. One of Mr. Chittick's duties was to take the golf inventions to a patent lawyer on behalf of the company. That was his first introduction to patent law and he liked what he saw. "The patent lawyer had his own office and a secretary, worked for himself, and didn't have anyone telling him what to do. I really liked that," remarked Mr. Chittick. That's when he took a lower paying job at the Patent Office, attended George Washington University Law School at night, and received his law degree in 1933.

Mr. Chittick began his career as a patent lawyer in Boston in 1934 and practiced law until he retired in 1972 from his own firm, *Chittick, Thompson and Pfund*.

Now living in a comfortable retirement facility in Concord, NH, Mr. Chittick doesn't golf as much as he used to, but still swings a club, and still plays the mandolin.

Under Secretary Dickinson and Commissioner Godici recently sent the following wishes to Mr. Chittick:

"On the occasion of your 100th birthday, we at the United States Patent and Trademark Office congratulate you on your status as the oldest living registered patent practitioner on record. Take pride in knowing that you are truly a living example of the lasting power of America's intellectual property system. At our Office, we truly appreciate the contributions that people like yourself have made to our Nation's prosperity, and to its rich history of innovation."

"We wish you many years of good health and continued success."

USPTO 2001 Spring Video Conference Center

E-Learning Lecture Schedule

The Video Conference Center Lectures reflect the USPTO's current and largest introduction into e-learning for its patent examiner and public sector constituents. It is offered through the USPTO's videoconferencing facilities in the Patent Academy and at several sites around the nation, primarily through facilities at Patent and Trademark Depository Libraries in Sunnyvale, California, Detroit, Michigan, and Houston, Texas.

The subjects offered mirror learning requirements in the ongoing in-house Practice and Procedures technical curriculum. Listed below is a schedule of upcoming courses for the next several months. Please remember that start times listed are Eastern Time. Each PTDL site is in a different time zone, therefore you must check for accurate local starting times. Most lectures run about two hours, however some may go as long as three hours. The schedule of lectures is confirmed for participation at the time of publishing, however it is subject to change based upon agency needs.

<u>TITLE</u>	<u>DATE</u>	<u>TIME</u> (Eastern Time)	<u>LECTURER</u>
Patent Cooperation Treaty (PCT) I	February 13, 2001	1:00 PM	Carol Bidwell
Patent Cooperation Treaty (PCT) II	February 15, 2001	1:00 PM	Carol Bidwell
Response by Applicant	February 20, 2001	1:00 PM	Carlos Azpuru
Double Patenting	February 22, 2001	1:00 PM	Leo Picard
Board of Patent Appeals and Interferences	March 13, 2001	1:00 PM	Bruce Stoner
Petitions	March 15, 2001	1:00 PM	Brian Hearn
Trademark Trial and Appeal Board Issues	March 27, 2001	1:00 P.M.	Cindy Greenbaum/Gerard Rogers
Unity of Invention	March 29, 2001	1:00 PM	Jerry Massie
PCT I	April 10, 2001	1:00 PM	Carol Bidwell
PCT II	April 12, 2001	1:00 PM	Carol Bidwell
Trademark Tips for Paralegals	April 24, 2001	1:00 PM	Janice Long/ Hope Slonim
112.2 nd Paragraph	April 26, 2001	1:00 PM	Nelson Moskowitz
Novelty 35 USC 102	May 01, 2001	1:00 PM	Tom Will
Affidavits 37 CFR 1.31 & 1.32	May 10, 2001	1:00 PM	David Lacey
Re-Issue and Re-Exam	May 15, 2001	1:00 PM	Kenneth Schor/ Joe Narcavavge
Obviousness 35 USC 103	May 24, 2001	1:00 PM	David Moore
New Rule Changes	June 05, 2001	1:00 PM	Robert J. Spar
Response by Applicant	June 07, 2001	1:00 PM	Carlos Azpuru
PCT I	June 19, 2001	1:00 PM	Carol Bidwell
PCT II	June 21, 2001	1:00 PM	Carol Bidwell

Contact your closest PTDL partnership library for more information or to register:

Sunnyvale Center for Innovation, Invention and Ideas
Sunnyvale, California
Phone: (408) 730-7290

Great Lakes Patent and Trademark Center
Detroit, Michigan
Phone: (313) 833-3379

**South Central Intellectual Property Partnership
at Rice University**
Houston, Texas
Phone: (713) 348-5196

VIDEOCONFERENCE COURSE DESCRIPTIONS

Due to the constantly changing nature of some of the subjects, updates will be noted during lectures. Descriptions are listed under Patents and Trademarks.

Patents

Affidavit Practice: 37 CFR 1.131 and 1.132:

The information provided in this session is a great benefit to attorneys/applicants because it teaches the USPTO's way of doing things. The lecture is designed to teach examiners the analytical skills needed to evaluate whether an affidavit filed under 37 CFR 1.131 may be used as evidence to swear behind a reference, and whether an affidavit filed under 37 CFR 1.132 may be used as evidence to overcome a ground of rejection or an objection. When attorneys/applicants know what is needed in each affidavit type, and when it is appropriate to employ an affidavit, prosecution can be much more effective, lending credence to the old saying "it ain't what you do but the way that you do it!"

Board of Patent Appeals and Interferences:

All you've ever wanted to know about the BPAI will be presented in this seminar: Who sits on the board, what training and experience are required, what is a panel, what each member does, and caseload considerations start the session. How the BPAI judges are trimming appeals inventory and speeding up interferences will also be discussed.

The lecturer will explain the process and procedures required when making an appeal to the Board including how to contact an oral conduct hearing, BPAI decisions and requests for rehearing. The BPAI also conducts and decides interferences, so the presenter will also cover the process used in an interference case.

Double Patenting:

Learn how the Patent Academy teaches examiners to treat applications containing claims which conflict with claims in applicant's other applications or patents, or claims in other commonly assigned (or owned) applications. Topics include:

- Grounds for prohibiting double patenting;
- Treatment of conflicting claims;
- Terminal disclaimers;
- Protection against Double Patenting rejections;
- Conflict between design and utility claims; and
- Duplicate claims

The session will end with an exercise that will enhance the absorption of the material presented.

Obviousness under 35 USC 103:

Understand the meaning of 35 USC 103. Learn to apply the standards used to establish a legal conclusion of obviousness. Treat the various issues that inevitably arise when applying 35 USC 103. By the end of this session, you should be able to recognize and understand the following concepts related to obviousness:

- The statute;
- Prima facie obviousness;
- The Graham test;
- Scope and content of prior art;
- Evidence of prior art comprising references, admissions and affidavits;
- Analogous art; and differences between the prior art and the claims at issue.

Attendees will also gain a level of skill in the pertinent art comprising:

- Motivation;
- Hindsight;
- Motivation different from applicant's;
- Art recognized equivalence for the same purpose;
- Physical incorporation;
- Destroying a reference;
- Changing principle of operation and number of references combined; and
- Secondary considerations comprising unexpected result; long felt need; and commercial success will also be discussed.

With all this valuable information, it is “obvious” that you need to take this class!

Novelty 35 USC 102:

Participants will learn to determine whether a reference qualifies as prior art under 35 USC 102 (a), (b), or (e) and determine whether a single reference teaches all the elements of a claimed invention.

Petitions:

Every patent attorney needs to know how to handle petitions expeditiously, efficiently and with a minimum of error. You will learn the basic principles of petition practice and the two main avenues of ex parte review – appeal and petition. Identify the various types and components of petitions handled in the Office of the Deputy Commissioner for Patent Examination Policy, as well as in the Examining Corp and the requirements that MUST be met to have a petition granted. Become more effective in your practice before the office by getting guidance on how to 1) avoid the most common errors that lead to petitions in the first place, and 2) avoid errors in the petitions themselves.

Proposed New Rule Changes (Based upon current or pending legislative issues):

The presentation will cover current rulemaking being undertaken by the PTO. Included will be preparation of a final rule on “Patent Business Goals” for which a Notice of Proposed Rulemaking was published, 64 Fed. Reg. 53772 (October 4, 1999). This includes topics such as; changes in obtaining small entity status, reduced time for filing corrected or formal drawings, permitting the electronic submission of voluminous material, such as computer program listings, restrictions on preliminary amendment practice. Also included are issues relating to PTO implementation of the American Inventor’s Protection Act of 1999 and of the Intellectual Property and Communications Omnibus Reform Act of 1999, such as Subtitle D – Patent Term Guarantee, Subtitle E – Domestic Publication of Patent Applications.

Re-Exam and Reissue:

The lecture provides an overview of the statutes (35 USC 251 and 35 USC 302-305), rules (37 CFR 1.171 – 1.179 and 37 CFR 1.510-1.552) and MPEP requirements governing reissue applications and ex parte reexamination proceedings, respectively. The objectives include enabling the practitioner to distinguish reissue practice from other means of correcting errors in issued patents, in particular ex parte reexamination practice. The attendee will also learn:

- To recognize the appearance of a reissue application or a reexamination proceeding by an inspection of its form and contents;
- To understand how the USPTO applies to the examination process the key provisions of the statutes;
- To recognize the importance of and the emphasis on a reissue oath/

declaration and to be able to distinguish such from the oath or declaration of a utility application; and

- Understand the primary similarities and differences between reissue applications, ex parte reexamination proceedings, and regular utility applications and their respective examinations.

35 USC 112-2 paragraph, Rejections Not Based on Prior Art:

This session will analyze the claims to determine whether or not one skilled in this art can determine the metes and bounds of a claim with a fair degree of certainty. Attendees will be taught to understand the criteria for determining clear and distinct claim language, and understand the policy reasons for 35 USC 112-2. The session also enables the practitioner to understand appropriateness of rejections in accordance with 35 USC 112.

Response by Applicant:

It is very important to understand the proper form when dealing with the USPTO. It makes life easier and helps avoid delays. This session enables the attendee to determine when a response to an Office Action is correct and complete. It will guide the applicant on the proper course of action to be taken when the response is incorrectly filed. To state it simply, it covers the who, what and when of responses-WHO is the proper person to file? WHAT is considered a proper response? And WHEN is it due?

Unity of Invention:

The objective is to understand unity of invention practice as it applies to national stage applications filed under 35 USC 371 and to international applications filed under the Patent Cooperation Treaty. The participants will be able to determine how unity of invention practice applies and whether claims in a given application lack unity of invention.

The Patent Cooperation Treaty:

This is a two-part lecture on the Patent Cooperation Treaty. Representatives from the PCT Special Programs Office of the USPTO teach a basic seminar on practice and procedures of the Patent Cooperation Treaty from filing an international application to entering the national phase in the USPTO.

Patent Cooperation Treaty (PCT) Part I:

The first session starts with an overview of the PCT process including the international phase and the national phase as well as the advantages of using PCT for filing foreign patent applications. Next the participants are given detailed information on how to file an international application. Participants are taught how to properly fill out a PCT Request form including information on using PCT-EASY, the self-validating software for generating the Request.

Patent Cooperation Treaty (PCT) Part II:

The second session continues with information on filing a Demand for International Preliminary Examination. Next participants learn about national stage entry in the US under 35 USC 371 and an alternative strategy for filing a US patent based upon the international application. The session ends with helpful hints on the PCT process including how to record changes in the applicant, how to delay or prevent publication of the international application, and a discussion of important forms that should be monitored during the international phase.

TRADEMARKS

Trademark Tips for Paralegals:

This seminar will provide an explanation of the trademark process aimed at non-attorney legal professionals. Legal staff of the Office of the Commissioner for Trademarks will provide an explanation of the trademark process, including an overview of the office and updates on pendency for new applications. They will provide insight on why trademark applications go abandoned; tips to avoid abandonment; and what to do when your application is abandoned. They will briefly explain the difference between a petition and an appeal and a petition and a request for reinstatement. They will also provide a list of contacts at the PTO and other handouts, to help you get the right answer, right away.

Trademark Trial and Appeal Board Issues:

Topics for discussion include: the pre-trial phase of opposition and cancellation proceedings including pleadings and discovery, the trial and decision phases of opposition and cancellation proceedings including the submission of trial evidence and how recently proposed rule changes would affect practice before the TTAB.

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